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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/713,143

11/17/2003

Diana Lynn Fitzgerald

ANA-101

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06/23/2010

EXAMINER

DUNN, MISHAWN N

ART UNIT

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2621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/713,143	<b>Applicant(s)</b> FITZGERALD ET AL.	
	<b>Examiner</b> MISHAWN DUNN	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/10</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, filed 3/15/2010, with respect to the rejection(s) of claim(s) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.
2. The official notice statement, taken in the previous office action, is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1, 8, 13, 15, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer (US Pat. No. 6,437,227) in view of Theis et al. (US Pat. No. 7,343,179).
5. Consider claim 1. Theimer teaches a system for storing music, comprising: a device for playing music that is heard by a subscriber; a request that is generated in response to a subscriber request to store music; a transmitter to transmit a request to obtain the music for storage (col. 4, line 66 – col. 5, line 4); a music database that is

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queried to obtain music responsive to the subscriber's request (col. 1, lines 27-33); and a storage device to receive the music and store the music (col. 8, lines 33-39).

Theimer does not teach allowing the subscriber to listen to the music without prior providing a list of potential song titles to the subscriber.

However, Theis et al. teaches allowing the subscriber to listen to the music without prior providing a list of potential song titles to the subscriber (abstract; col. 3, line 35 – col. 4, line 9).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to use, to allow the subscriber to listen to the music without prior providing a list of potential song titles to the subscriber, in order to allow the user to preview a ring tone before purchasing.

6. Consider claim 8. Theimer teaches the system recited in claim 1, wherein the music database is provided by a third party (col. 1, lines 21-24).

7. Claims 13, 15, and 16 are rejected using similar reasoning as the corresponding claims above.

8. Claims 2, 3, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer (US Pat. No. 6,437,227) in view of Theis et al. (US Pat. No. 7,343,179) in further view of Official Notice.

9. Consider claim 2. Theimer and Theis et al. teach all claimed limitations as stated above, except wherein the storage device is located in a vehicle in which the listener is located.

However, the examiner takes official notice that it is well known in the art to place a storage device in a vehicle. Official notice is taken.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to incorporate storing of music data in a vehicle, in order to have easy and mobile access to the stored music data.

10. Consider claim 3. Theimer teaches the system recited in claim 2, wherein the storage device is one of a CD-ROM, a DVD and a RAM (col. 8, lines 33-39).

11. Consider claim 14. Theimer teaches all claimed limitations as stated above, except detecting the push of a button to receive the indication from the subscriber.

However, the examiner takes official notice that it is well known in the art to press a button to request data.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to incorporate the use of detecting a push of a button, in order to be able to receive request from a user.

12. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer (US Pat. No. 6,437,227) in view of Theis et al. (US Pat. No. 7,343,179) in further view of Kikuchi et al. (US Pat. No. 7,356,557).

13. Consider claim 4. Theimer and Theis et al. teach all claimed limitations as stated above, except wherein the storage device is located in a telephone and the music is transmitted in a ring tone format for storage as a ring tone in the telephone.

However, Kickuchi et al. teaches wherein the storage device is located in a telephone and the music is transmitted in a ring tone format for storage as a ring tone in the telephone (col. 11, lines 46-52).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to incorporate the use of ring tone format to store music, in order to make the reproduction of the music associated with incoming call.

14. Consider claim 5. Theimer teaches the system recited in claim 4, wherein only a portion of the music is stored in the telephone (col. 8, lines 14-17).

15. Consider claim 6. The system recited in claim 4, wherein the telephone is a cellular telephone (col. 4, line 66 - col. 5, line 4).

16. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer (US Pat. No. 6,437,227) in view of Theis et al. (US Pat. No. 7,343,179) in further view of Eyal et al. (U.S. Pub. No. 2007/0177586).

17. Consider claim 7. Theimer and Theis et al. teach all claimed limitations as stated above, except a music play list comprising a list of songs that are played, wherein when the listener makes the request for storing the music, the music play list is consulted to determine which music is being played at the time of the request.

However, Eyal et al. teaches a music play list comprising a list of songs that are played, wherein when the listener makes the request for storing the music, the music play list is consulted to determine which music is being played at the time of the request (para. 0110).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to incorporate the use of a play list, in order to allow flexibility of reproduction of the music stored.

18. Claim 17 is rejected using similar reasoning as the corresponding claim above.

19. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer (US Pat. No. 6,437,227) in view of Theis et al. (US Pat. No. 7,343,179) in further view of Sako (US Pat. No. 7,093,754).

20. Consider claim 9. Theimer and Theis et al. teach all claimed limitations as stated above, except wherein the listener is billed to store the music.

However, Sako teaches wherein the subscriber is billed to store the music (col. 11, lines 56-58; col. 25, lines 4-9).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to bill the subscriber to store the music, in order to allow the user to receive discounted services based on their purchase history.

21. Consider claim 10. Sako teaches the system recited in claim 9, wherein the listener is billed to store the music on a per-use basis (col. 11, lines 56-58).

22. Consider claim 11. Sako teaches the system recited in claim 9, wherein the listener is billed to store the music on a periodic basis (col. 25, lines 4-9).

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23. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer (US Pat. No. 6,437,227) in view of Theis et al. (US Pat. No. 7,343,179) in further view of Tanaka et al. (US Pat. No. 7,113,927).

24. Consider claim 12. Theimer and Theis et al. teach all claimed limitations as stated above, except wherein the subscriber prepays to store the music.

However, Tanaka et al. teaches wherein the subscriber prepays to store the music (col. 12, lines 40-46).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to setup a prepayment plan for subscribers, in order to give users the options of not having to commit.

25. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer (US Pat. No. 6,437,227) in view of Theis et al. (US Pat. No. 7,343,179) in further view of Galdos (U.S. Pub. No. 2005/0031314).

26. Consider claim 18. Theimer and Theis et al. teach all claimed limitation as stated above, except reformatting a video data prior to storing.

However, Galdoes teaches reformatting a video data prior to storing (para. 0012).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to incorporate reformatting of music file, in order to optimize storage space.



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27. Consider claim 19. Galdos teaches reformatting a video data prior to storing in accordance with the storage device prior to receiving the music for storage (para. 0012).
28. Claim 20 is rejected using similar reasoning as the corresponding claims above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to trswhose telephone number is (571)272-7635. The examiner can normally be reached on Monday - Friday 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 2621

June 19, 2010

/JAMIE JO ATALA/

Primary Examiner, Art Unit 2621